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09/769,906	01/25/2001	Matthew Bruce Tropper		5001

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EXAMINER	
PHAM, HUNG Q	
ART UNIT	PAPER NUMBER
2162	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,906

Applicant(s)

TROPPEL, MATTHEW BRUCE

Examiner

HUNG Q PHAM

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/26/2004 has been entered.

As in the request for continued examination, claims 1-2, 4 and 16-22 were canceled. New claims 23-42 were added. The pending claims are 23-42.

Response to Arguments

2. Applicant's arguments filed 02/26/2004 have been fully considered but they are not persuasive.

(a) As argued by applicant on pages 7-8:

While the applicant agrees with the Examiner that Rivette et al. '767 discloses such "backward" and "forward" citation reports (see, e.g., Col. 87 line 5 to Col. 89 line 53 as well as Figs. 61-65, 86 and 87), it is respectfully submitted that Rivette et al. '767 nowhere shows or suggests the claimed method, wherein, once the enumerated searching, operating and displaying steps begin, each of the enumerated searching, operating and displaying steps is carried out without additional patent identification input from the user.

Examiner respectfully traverses because of the following reasons:

As shown in FIG. 163 is a dialogue box, and an operator can identify whether he/she wishes to perform a forward or backward search. Thus, in order to have a backward search, then a forward search based on the result of the backward, obviously, the dialogue box could be modified to include the backward and forward search at a certain level by checking two boxes, and the level is 1 level deep. By modifying the dialogue box, the *searching, operating and displaying steps is carried out without additional patent identification input from the user.*

(b) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning as on page 8, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 23-27 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. [USP 6,339,767 B1] in view of Davis, III et al. [USP 5,873,079].**

Regarding to claim 23, Rivette teaches a method of maintaining databases of patents. As shown in Fig. 6 is the databases 316, which store patent information, and information pertinent to the analysis of the document information (Rivette, Col. 17, line 16-Col. 23, line 25). As shown in FIG. 157, in order to view a patent citation tree, an operator at a network client selects a patent from a listing of patents displayed in document pane 16104. The patent selected shall be referred to as the 484 patent (Rivette, Col. 125, Lines 25-38). As seen, 484 as *an identification of the patent under test is inputted by the user to the computer*. In order to build a patent citation tree, two kinds of searches are used, backward and forward search. Backward is to search the cited patents in a queried source patent (Col. 87, Lines 40-42), and forward is to search the patents that cite a queried source patent (Col. 89, Lines 39-40). Returning to the FIG. 157 in step 15710, the network client 306 presents a dialogue box as in FIG. 163 to the

operator. In this dialogue box 16302, the operator identifies whether he wishes to perform a forward citation function or a backward citation function. Also, the operator defines the scope of the citation analysis to be performed by indicating the number of levels that should be cited (Rivette, Col. 125, Lines 52-59). As seen, the technique in step 15710 indicates the step of *inputting by the user, to the computer, a command to display patents in the database, which relate to the 484 as patent under test*. For patent citations of greater than one level, for example, a backward patent citation of two levels then the process identified that patents P1 and P2 are cited in the 484 patent (Rivette, Col. 126, Lines 30-35). As seen, P1 and P2 returned from backward patent citation indicate the step of *searching the database and storing as first generation data identifying data corresponding to at least one patent in the database which is cited in the 484 as patent under test*. The second level refers to the patents that are cited in patents P1 and P2. Accordingly, the enterprise server must perform the operations for each of patents P1 and P2, to identify the patents cited in P1 and P2 (Rivette, Col. 126, Lines 45-49). As seen, the identified patents in response to the operation to identify patents cited in P1 and P2 indicates the step of *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which is cited in at least one patent identified by the first generation data*. As shown in FIG. 159, steps 15902-15904 perform the step of *displaying at least the operated-on second generation data to the user*.

Rivette does not explicitly teach the step of *operating on the second generation data to filter out at least one patent identified in the second generation data that is cited in the*

patent under test, wherein the display does not include any patents filtered out by the operating step, and once the searching, operating and displaying steps begin, each of the searching, operating and displaying steps is carried out without additional patent identification input from the user.

However, as shown in FIG. 163 is a dialogue box, and an operator can identify whether he/she wishes to perform a forward or backward search. Thus, in order to have a backward search, then a forward search based on the result of the backward. Obviously, the dialogue box could be modified to include the backward and forward search checking two boxes, and the level is 1 level deep. By modifying the dialogue box, the searching, operating and displaying steps is carried out *without additional patent identification input from the user.*

Davis teaches a method for structuring queries and executing queries for databases. Davis further discloses the results obtained by searching multiple indices must typically be post-processed to eliminate duplicate references to the same record that may have been obtained from the different indices (Davis, Col. 9, Lines 19-29).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette method by automatically invoking the forward search after a backward at a specified level to identify the duplicate cited patents between the first and second level, combining the three function into one, then eliminating the duplicates as taught by Davis in order to eliminate duplicate cited patents in a patent citation tree.

Regarding to claim 33, Rivette teaches a method of maintaining databases of patents. As shown in Fig. 6 is the databases 316, which store patent information, and information pertinent to the analysis of the document information (Rivette, Col. 17, line 16-Col. 23, line 25). As shown in FIG. 157, in order to view a patent citation tree, an operator at a network client selects a patent from a listing of patents displayed in document pane 16104. The patent selected shall be referred to as the 484 patent (Rivette, Col. 125, Lines 25-38). As seen, 484 as *an identification of the patent under test is inputted by the user to the computer*. In order to build a patent citation tree, two kinds of searches are used, backward and forward search. Backward is to search the cited patents in a queried source patent (Col. 87, Lines 40-42), and forward is to search the patents that cite a queried source patent (Col. 89, Lines 39-40). Returning to FIG. 157 in step 15710, the network client 306 presents a dialogue box as in FIG. 163 to the operator. In this dialogue box 16302, the operator identifies whether he wishes to perform a forward citation function or a backward citation function. Also, the operator defines the scope of the citation analysis to be performed by indicating the number of levels that should be cited (Rivette, Col. 125, Lines 52-59). As seen, the technique in step 15710 indicates the step of *inputting by the user, to the computer, a command to display patents in the database, which relate to the 484 as patent under test*. For patent citations of greater than one level, for example, a backward patent citation of two levels then the process identified that patents P1 and P2 are cited in the 484 patent (Rivette, Col. 126, Lines 30-35). As seen, P1 and P2 returned from backward patent citation indicate the step of *searching the database and storing as first generation data identifying*

data corresponding to at least one patent in the database which is cited in the 484 as patent under test. The second level refers to the patents that are cited in patents P1 and P2. Accordingly, the enterprise server must perform the operations for each of patents P1 and P2, to identify the patents cited in P1 and P2 (Rivette, Col. 126, Lines 45-49). Rivette further discloses a single search command for a forward citation function is issued for each level of the citation function. For example, a first search command is issued to identify all patents that cite a patent P1, and suppose that patents P2, P3, and P4 are identified by this first search command (Col. 126, Lines 40-49). As seen, within the patents of the second level patents as discussed above, if there is one that cited in the patents of the first level, or in different words, the patent identified by the first generation data could be identified by applying a forward search after a backward search at the second level, and the technique of forward after a backward at the second level indicates the step of *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which cites at least one patent identified by the first generation data*, or the patents *cited in the patent under test*, and this indicates a duplication in the patent citation tree. As shown in FIG. 159 steps 15902-15904 performs the step of *displaying at least the operated-on second generation data to the user*.

Rivette does not explicitly teach the step of *operating on the second generation data to filter out at least one patent identified in the second generation data that is cited in the patent under test*, wherein *the display does not include any patents filtered out by the operating step*, and *once the searching, operating and displaying steps begin, each of the*

searching, operating and displaying steps is carried out without additional patent identification input from the user.

Davis teaches a method for structuring queries and executing queries for databases. Davis further discloses the results obtained by searching multiple indices must typically be post-processed to eliminate duplicate references to the same record that may have been obtained from the different indices (Davis, Col. 9, Lines 19-29).

Obviously, the backward search, forward search, citation tree displaying could be combined into one to carry out without additional patent identification input.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette method by automatically invoking the forward search after a backward at a specified level to identify the duplicate cited patents between the first and second level, combining the three function into one, then eliminating the duplicates as taught by Davis in order to eliminate duplicate cited patents in a patent citation tree.

Regarding to claims 24 and 34, Rivette and Davis teaches all the claimed subject matters as discussed in claims 23 and 33, Rivette does not explicitly teach the steps searching, operating and displaying are carried out in the order. However, as discussed in claim 23, the searching step has to be before the operating step in order to have a duplication to be eliminated, and obviously is the displaying step for the result. It would have been obvious for one of ordinary skill in the art at the time the invention was made

to modify the Rivette and Davis method by putting these steps in order for a patent citation search.

Regarding to claims 25 and 35, Rivette and Davis teaches all the claimed subject matters as discussed in claims 23 and 33, Rivette further discloses the step of *displaying both the operated-on second generation data nod the first generation data to the user* (Rivette, FIG. 164).

Regarding to claims 26 and 36, Rivette and Davis teaches all the claimed subject matters as discussed in claims 23 and 33, and the steps of storing were discussed as set forth in claim 23.

Regarding to claims 27 and 37, Rivette and Davis teaches all the claimed subject matters as discussed in claims 23 and 33, Rivette further discloses the *input is made using a first computer including a web browser and the searching is performed by a second computer, which first computer and second computer are connected to the Internet* (Rivette, FIG. 8).

5. Claims 28-32 and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. [USP 6,339,767 B1].

Regarding to claim 28, Rivette teaches a method of maintaining databases of patents. As shown in Fig. 6 is the databases 316, which store patent information, and information pertinent to the analysis of the document information (Rivette, Col. 17, line 16-Col. 23, line 25). As shown in FIG. 157, in order to view a patent citation tree, an operator at a network client selects a patent from a listing of patents displayed in document pane 16104. The patent selected shall be referred to as the 484 patent (Rivette, Col. 125, Lines 25-38). As seen, 484 as *an identification of the patent under test is inputted by the user to the computer*. In order to build a patent citation tree, two kinds of searches are used, backward and forward search. Backward is to search the cited patents in a queried source patent (Col. 87, Lines 40-42), and forward is to search the patents that cite a queried source patent (Col. 89, Lines 39-40). Returning to FIG. 157 in step 15710, the network client 306 presents a dialogue box as in FIG. 163 to the operator. In this dialogue box 16302, the operator identifies whether he wishes to perform a forward citation function or a backward citation function. Also, the operator defines the scope of the citation analysis to be performed by indicating the number of levels that should be cited (Rivette, Col. 125, Lines 52-59). As seen, the technique in step 15710 indicates the step of *inputting by the user, to the computer, a command to display patents in the database, which relate to the 484 as patent under test*. For patent citations of greater than one level, for example, a backward patent citation of two levels

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then the process identified that patents P1 and P2 are cited in the 484 patent (Rivette, Col. 126, Lines 30-35). As seen, P1 and P2 returned from backward patent citation indicate the step of *searching the database and storing as first generation data identifying data corresponding to at least one patent in the database which is cited in the 484 as patent under test*. The second level refers to the patents that are cited in patents P1 and P2. Accordingly, the enterprise server must perform the operations for each of patents P1 and P2, to identify the patents cited in P1 and P2 (Rivette, Col. 126, Lines 45-49). As seen, the identified patents in response to the operation to identify patents cited in P1 and P2 indicates the step of *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which is cited in at least one patent identified by the first generation data*. As shown in FIG. 159 steps 15902-15904 performs the step of *displaying at least the operated-on second generation data to the user*. Rivette does not explicitly teach the step of *operating on the second generation data to identify at least one patent identified in the second generation data that is cited in the patent under test*, wherein *the display identifies at least one patent that is cited in the patent under test*, and *once the searching, operating and displaying steps begin, each of searching, operating and displaying steps is carried out without additional patent identification input from the user*.

However, Rivette further discloses a single search command for a forward citation function is issued for each level of the citation function. For example, a first search command is issued to identify all patents that cite a patent P1, and suppose that patents P2, P3, and P4 are identified by this first search command (Col. 126, Lines 40-

49). As seen, within the patents of the second level patents as discussed above, the one that cited in patent 484 could be identified by applying a forward search after a backward search at the second level. As further disclosed by Rivette, the web client when displaying the patent citation tree, color codes could be used to emphasize the nodes of the patent citation tree according to some user selected criteria, such as ownership, assignee, relative age, issue date, filing date, user-defined criteria, etc. (Rivette, Col. 134, Lines 23-28). Obviously, the identified patents returned from the forward search could be distinguish from the regular ones by performing a particular color code for identifying purpose, and the backward search, forward search, citation tree displaying could be combined into one to carry out without additional patent identification input.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette method by automatically invoking the forward search after a backward at a specified level to identify the duplicate cited patents between the first and second level, combining the three functions into one, using a particular color code for the duplicate in order to distinguish the duplicate cited patents in a patent citation tree.

Regarding to claim 38, Rivette teaches a method of maintaining databases of patents. As shown in Fig. 6 is the databases 316, which store patent information, and information pertinent to the analysis of the document information (Rivette, Col. 17, line 16-Col. 23, line 25). As shown in FIG. 157, in order to view a patent citation tree, an

operator at a network client selects a patent from a listing of patents displayed in document pane 16104. The patent selected shall be referred to as the 484 patent (Rivette, Col. 125, Lines 25-38). As seen, 484 as *an identification of the patent under test is inputted by the user to the computer*. In order to build a patent citation tree, two kinds of searches are used, backward and forward search. Backward is to search the cited patents in a queried source patent (Col. 87, Lines 40-42), and forward is to search the patents that cite a queried source patent (Col. 89, Lines 39-40). Returning to FIG. 157 in step 15710, the network client 306 presents a dialogue box as in FIG. 163 to the operator. In this dialogue box 16302, the operator identifies whether he wishes to perform a forward citation function or a backward citation function. Also, the operator defines the scope of the citation analysis to be performed by indicating the number of levels that should be cited (Rivette, Col. 125, Lines 52-59). As seen, the technique in step 15710 indicates the step of *inputting by the user, to the computer, a command to display patents in the database, which relate to the 484 as patent under test*. For patent citations of greater than one level, for example, a backward patent citation of two levels then the process identified that patents P1 and P2 are cited in the 484 patent (Rivette, Col. 126, Lines 30-35). As seen, P1 and P2 returned from backward patent citation indicate the step of *searching the database and storing as first generation data identifying data corresponding to at least one patent in the database which is cited in the 484 as patent under test*. The second level refers to the patents that are cited in patents P1 and P2. Accordingly, the enterprise server must perform the operations for each of patents P1 and P2, to identify the patents cited in P1 and P2 (Rivette, Col. 126, Lines 45-49).

Rivette further discloses a single search command for a forward citation function is issued for each level of the citation function. For example, a first search command is issued to identify all patents that cite a patent P1, and suppose that patents P2, P3, and P4 are identified by this first search command (Col. 126, Lines 40-49). As seen, within the patents of the second level patents as discussed above, if there is one that cited in the patents of the first level, or in different words, the patent identified by the first generation data could be identified by applying a forward search after a backward search at the second level, and the technique of forward after a backward at the second level indicates the step of *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which cites at least one patent identified by the first generation data*, or the patents *cited in the patent under test*, and this indicates a duplication in the patent citation tree. As shown in FIG. 159 steps 15902-15904 performs the step of *displaying at least the operated-on second generation data to the user*.

Rivette does not explicitly teach the step of *operating on the second generation data to identify at least one patent identified in the second generation data that is cited in the patent under test*, wherein *the display identifies at least one patent that is cited in the patent under test*, and *once the searching, operating and displaying steps begin, each of the searching, operating and displaying steps is carried out without additional patent identification input from the user*.

As further disclosed by Rivette, the web client when displaying the patent citation tree, color codes could be used to emphasize the nodes of the patent citation tree

according to some user selected criteria, such as ownership, assignee, relative age, issue date, filing date, user-defined criteria, etc. (Rivette, Col. 134, Lines 23-28).

Obviously, the identified duplicate patents returned from the forward search could be distinguish from the regular ones by performing a particular color code for identifying purpose, and the backward search, forward search, citation tree displaying could be combined into one to carry out without additional patent identification input.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette method by automatically invoking the forward search after a backward at a specified level to identify the duplicate cited patents between the first and second level, combining the three functions into one, using a particular color code for the duplicate in order to distinguish the duplicate cited patents in a patent citation tree.

Regarding to claims 29 and 39, Rivette and Davis teaches all the claimed subject matters as discussed in claims 28 and 38, Rivette does not explicitly teach the steps searching, operating and displaying are carried out in the order. However, as discussed in claim 23, the searching step has to be before the operating step in order to have a duplication to be eliminated, and obviously is the displaying step for the result. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette and Davis method by putting these steps in order for a patent citation search.

Regarding to claims 30 and 40, Rivette and Davis teaches all the claimed subject matters as discussed in claims 28 and 38, Rivette further discloses the step of *displaying both the operated-on second generation data nod the first generation data to the user* (Rivette, FIG. 164).

Regarding to claims 31 and 41, Rivette and Davis teaches all the claimed subject matters as discussed in claims 28 and 38, and the steps of storing were discussed as set forth in claim 23.

Regarding to claims 32 and 42, Rivette and Davis teaches all the claimed subject matters as discussed in claims 28 and 38, Rivette further discloses the *input is made using a first computer including a web browser and the searching is performed by a second computer, which first computer and second computer are connected to the Internet* (Rivette, FIG. 8).


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 703-605-4242. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
April 7, 2004


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100